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ATTORNEY'S DOCKET NUMBER: 2003080-0089 (SK-744-CON3)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Danishefsky et al.

Serial No.: 10/058,695

Filed: June 5, 2001

For: Synthesis of Epothilones, Intermediates Thereto, Analogues and Uses Thereof

Examiner: T. Solola

Group Art Unit: 1626

Box: AF

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

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March 21, 2003

REQUEST FOR WITHDRAWAL OF FINAL OFFICE ACTION

A Final Office Action was issued in the above-referenced case on February 19, 2003.

Upon review of that Action, Applicant has determined that the finality of the Action is inappropriate because the presently claimed invention was not previously examined. Applicant respectfully requests withdrawal of the Final Office Action, and issuance instead of either (a) a Non-final Office Action; or (b) a Notice of Allowance.

The present Application was filed on January 28, 2002, as a continuation of USSN 09/874,514, filed June 5, 2001, which is a continuation of USSN 08/986,025, now issued as U.S. Patent 6,242,469. The claims then pending in the application were finally rejected as allegedly obvious over a single reference (and also were provisionally rejected for allegedly claiming the same invention as co-pending Patent Application Serial Number 09/874,514) in a Final Office Action mailed February 19, 2003. In response to that Final Office Action, Applicant submitted a Request for Continued Examination (RCE) on January 21, 2003. The RCE filing included an Amendment canceling several claims and amending others. The first Office Action after the

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RCE filing was issued on February 19, 2003 as a Final Office Action. It is this Final Office Action that should be withdrawn.

The first Office Action issued after the filing of an RCE may properly be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met (see MPEP § 706.07(h)). MPEP § 706.07(b) provides:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Thus, in the present case, the finality of the Office Action mailed February 19, 2003 would only have been proper if *all* of the claims pending after the filing of the RCE were drawn to the same invention claimed prior to the filing of the RCE, and *all* of the pending claims would have been properly subject to a final rejection had they been present prior to the RCE filing. These conditions are not met.

To give but one example, presently pending claim 112 includes a schedule for administering the recited pharmaceutical composition at least twice in a seven-day period. No claim reciting this schedule was ever present in the application prior to the RCE filing (nor had such a claim been pending in 09/874,514, over which a double patenting rejection has been levied). Thus, the subject matter of this claim has never been searched or considered by the Examiner. The only prior art reference relied upon in rejecting the pending claims has no teaching or suggestion of *any* administration schedule for a pharmaceutical composition (or of


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any pharmaceutical composition), let alone of a schedule of administration at least twice in a seven-day period. Final rejection of this claim is therefore improper.

In light of this and other differences between the presently pending claims and the prior claims, Applicant respectfully submits that the finality Office Action mailed February 19, 2003 is improper and should be withdrawn.

Please charge any fees that may be associated with this matter, or credit any overpayments, to our Deposit Account Number 03-1721.

Respectfully submitted,



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Dated: March 21, 2003.

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